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09/800909

| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
|--------------------|-------------|-----------------------|------------------|
| 09/800,909 | 03/08/01 | WALLACH | D WALLACH=12B |
| | | | EXAMINER |

HM22/0530

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| | |
|----------|--------------|
| SEARCHED | INDEXED |
| ART UNIT | PAPER NUMBER |

1644
1644

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DATE MAILED: 05/30/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 5/05/01

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-16 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☐ Claim(s) _____ is/are rejected.
☐ Claim(s) _____ is/are objected to.
☒ Claim(s) 1-16 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
☐ Interview Summary, PTO-413
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

DETAILED ACTION

1. Applicant's communication, filed 3/8/01, has placed this application in compliance with the Sequence Rules.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-10, drawn to nucleic acids encoding ligand, vectors, transformants and expression thereof, classified in Class 536, subclasses 23.5 Class 435, subclasses 69.1, 252.3, 320.1, 440.

II. Claim 11, drawn to an anti-idiotypic antibody, classified in Class 530, subclass 387.2.

It is noted that claim 11 is ambiguous in that it is unclear whether the claim is drawn solely to anti-idiotypic antibodies or to anti-idiotypic antibodies and anti-TNF antibodies.

If the latter is the case, then this Group would be subject to further restriction between anti-idiotypic antibodies and anti-TNF antibodies; given their distinct physicochemical structures and properties.

III. Claims 12-16, drawn to a method of inhibiting the function of the natural ligand receptor of the TNF/NGF receptor family with an antibody, classified in Class 424, subclass 130.1+.

It is noted these claims are ambiguous in that it is unclear whether antibodies of the 67 group are the same as the anti-stalk region antibodies.

If not, then this Group would be subject to further restriction between methods of inhibiting with antibodies of the 67 group and anti-stalk region antibodies.

2. Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)).

In the instant case, the products as claimed can be used in a materially different process such as affinity purification procedures or detection assays.

3. Inventions I and II are different products. Nucleic acids and antibodies/proteins are distinct because their structures and modes of action are different, which require non-coextensive searches. Therefore, they are patentably distinct.

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The DNA, vector and host as well as the method of making a protein using DNA will be examined together because the host and vector are expressly used for the purpose of protein expression.

Also, Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)).

In the instant case, the antibodies/proteins can be made via a variety of recombinant and biochemical means.

4. Because these inventions are distinct for the reasons given above and the search required for any Group from Groups I-III is not required for any other group from Groups I-III and Groups I-III have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Phillip Gambel
Phillip Gambel, PhD.
Primary Examiner
Technology Center 1600
May 29, 2001